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09/407,053	09/27/1999	RICHARD L. PALINKAS	D-6394	2219

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EXAMINER

PEZZLO, BENJAMIN A

ART UNIT PAPER NUMBER

3683

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 23

Application Number: 09/407,053  
Filing Date: September 27, 1999  
Appellant(s): PALINKAS, RICHARD L.

Mr. Ronald MacDonald  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**

MAY 6 2003

**GROUP 3600**

This is in response to the appeal brief filed 17 April 2003.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

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**(7) *Grouping of Claims***

Appellant's brief includes a statement that the claims of Group 1: 1, 3, 5-8, 10-14, 17, and 18; Group 2: 15, 19, and 20; and, Group 3: 21 and 22 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

Inventor	U.S. Patent Number
Carlston	4,998,997
Magowan	136,079
Platkiewicz et al.	4,465,799
Curtis et al.	5,036,774
Spencer et al.	US 5,086,707

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 5-8, 10-14, 17, and 18 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 18.

Group 2: Claims 15, 19, and 20 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 18.

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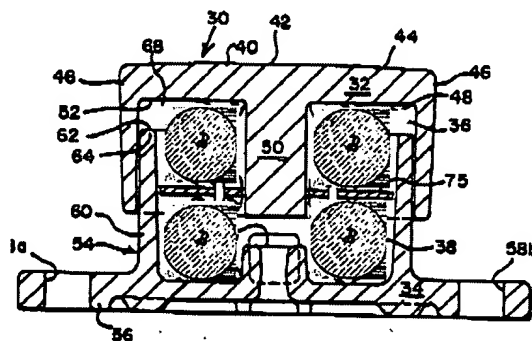
Group 3: Claims 21 and 22 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 18.

**(11) Response to Argument**

**Issue 1**

Carlston provides a side bearing unit for a railroad car (see the title of Carlston) and Magowan provides an India rubber spring that "may be applied with advantage to railway cars" (see pg. 1, col. 2, lines 24-26 of Magowan). Thus, one of ordinary skill in the art of rail car side bearing pads would have been aware of the disclosures provided by both Carlston and Magowan.

That the teachings of the prior art can be combined is illustrated below wherein a basic Carlston type bearing pad is provided with Magowan type solid toroidal springs:



**Illustration created by examiner: Carlston in view of Magowan**

The prior art also suggests the desirability of the claimed combination. As shown above, arrival at the combination would have required replacing the hollow springs of Carlston with the known solid type toroidal springs disclosed by Magowan. Multiple motivating factors are provided by Magowan for this modification. Specifically, Magowan states that a bearing pad

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with solid toroidal springs is provided with a high degree of elasticity, exhibits great bearing strength; and, is cheap to manufacture (see pg. 1 col. 1 lines 10-13 or Magowan).

Applicant argues that the Examiner has not explained the specific understanding or principle within the statement identified in the Magowan reference that would motivate one to make the cited combination. The specific understandings or principles called for by Applicant seem to be self evident from the motivations provided by Magowan, again, that it is desirous to have a bearing pad that has great strength, and/or that exhibits a high degree of elasticity, and/or that is cheap to manufacture. In other words, the specific understandings and principles touted by Magowan for the use of solid toroidal springs would have motivated one of ordinary skill in the art to use such springs.

Applicant further states that the Examiner "has acknowledged that Carlston teaches away from the combination" because Carlston discloses hollow springs. However, merely indicating that the base reference lacks solid toroidal springs is hardly an acknowledgement that the reference teaches away. On the contrary, the disclosure of Carlston is itself somewhat suggestive of combination with Magowan. As Applicant points out, Carlston's springs provide a specific type of elasticity, a so-called non-linear type of elasticity. One skilled in the art at the time the invention was made would be motivated by consideration of the specific spring rate provided by Carlston to look to another type of elasticity, specifically, the "high degree of elasticity" provided by the old type of springs, i.e. solid toroidal springs, disclosed by Magowan.

With regard to the "at least one slip lining positioned between the first housing exterior surface and a bore wall defining the second housing bore", Applicant argues that motivation is

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lacking in the prior art to provide a Plakiewicz slip lining between the first and second housings of a Carlston type device.

However, as Applicant admits, "Plakiewicz may disclose a material for the slip lining of claim 1". Plakiewicz et al. motivate use of their slip lining by espousing its capacity to generally improve the utilization of slide surfaces, see Plakiewicz col. 1 lines 59-60. It would have been readily apparent to one of ordinary skill at the time the invention was made that the housings of Carlston present such slide surfaces appropriate for a Plakiewicz slip lining.

Thus, by itself, Plakiewicz would have provided one of ordinary skill in the art at the time the invention was made sufficient motivation to use a slip lining between the two housings of a Carlston device. Further motivation to have included a Plakiewicz slip lining in a Carlston device is provided by Curtis and Spencer both of whom specifically recognize the wear problem which exists between the housings of bearing pads. More specifically, Curtis et al. teach that it is desirous to "permit sliding of the top cap member around the sleeve member" (Curtis et al.: col. 4 lines 66-68) and Spencer et al. state that it is desirous to "automatically adjust and compensate for wear between cap and base parts (Spencer et al.: col. 1 lines 57-58).

With regard to claims 11 and 12, applicant argues that the references fail to teach or suggest multiple slip linings, specifically, separate slip linings being attached to the first and second housing bore walls, respectively. However, Plakiewicz appears to disclose that a pair of surfaces may each be provided with the slip lining see col. 2 line 67, "rubbing pair". Moreover the MPEP specifically addresses situations where "if one slip lining is good then two slip linings is better", specifically, see MPEP 2144.04.VI.B: "Duplication of Parts", specifically, "the mere

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duplication of parts has no patentable significance unless a new and unexpected result is produced".

With regard to Issue 2, all of the arguments made hereinabove regarding the combination of Carlston and Magowan references with respect to claim 1 apply equally to claim 15.

With regard to Issue 3, the arguments made hereinabove with respect to claims 11 and 12 apply equally to claims 21 and 22.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

BAP  
May 3, 2003

Conferees

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